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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,325	07/01/2004	David S. Bonalle	70655.2300	4324
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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/710,325	BONALLE ET AL.	
	Examiner	Art Unit	
	Daniel I. Walsh	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-04, 8-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 7-1-04 and 8-5-05.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No.

10/708,832. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn towards contactless systems using hand auditory

emissions. The current application recites a smartcard, whereas the '832 application recites a transponder. The Examiner notes that a smartcard can be interpreted as a type of transponder/interchangeable with a transponder, and for this reasons, the claims are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Re claim 1 of the current Application the Applicants claim "A smartcard...reader...auditory emissions scan...facilitate a transaction." (re claim 1), whereas in the '832 Patent Application the Applicants claim "'A transponder...reader... auditory emissions scan... facilitate a transaction.'" (re claim 1).

Re claim 22 of the current Application, the Applicants claim "A method...smartcard... auditory emissions scan...transaction." (re claim 22), whereas in the '832 Patent Application the Applicants claim "method...transponder... auditory emissions scan...transaction." (re claim 22).

Re claim 34 of the current Application, the Applicants claim "A method...smartcard... auditory emissions scan...scan sample." (re claim 34), whereas in the '832 Patent Application the Applicants claim "A method...transponder... auditory emissions scan...scan sample." (re claim 34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-9, 11-15, 19-30, 32-40, and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209) in view of Baumann (US 6,104,922). Re the pending claims, the Examiner notes that Black teaches a transponder can be a smartcard (paragraph [0014]) for example.

Re claim 1, Black teaches a smartcard configured to communicate with a reader, a reader configured to communicate with the system, a biometric scan sensor configured to detect a proffered biometric sample, the biometric scan sensor configured to communicate with the system, and a device configured to verify the proffered hand geometry scan sample to facilitate a transaction (abstract and FIG. 1A).

Black is silent to auditory emissions as a biometric.

The Examiner notes that it is well known and conventional in the art that many different types of biometric data exists to authenticate a user, where the data/sample represents a unique feature of an individual user. Auditory emissions/voice is a well established biometric.

Nonetheless, the Examiner notes Baumann teaches auditory emissions/voice (col 4, lines 40+).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Baumann.

One would have been motivated to do this in order to have alternative biometrics for system constraints, desired complexity/security, accuracy of authentication, etc.

Re claim 2, the sensor is configured to communicate with the system via at least one of a smartcard, reader, and network (FIG. 1A).

Re claim 3, the scan sensor is configured to facilitate a finite number of scans (namely one).

Re claim 4, Black teaches the sensor is configured to log at least one of a detected scan sample, processed scan sample, and stored scan sample (FIG. 5A+, paragraph [0125], and FIG. 10A+).

Re claims 5-6 and 44 Black teaches (col 6, lines 56+) that the customer record can be stored locally or remotely. Though silent to a datapacket stored on a database, Black teaches the customer record can include biometric information, user information, etc. (FIG. 5A+ for example), which is interpreted as a datapacket. It would have been obvious to store such information on a database, in order to have a well known and conventional means of storing data for retrieval and organization. It would have been obvious to store the data remotely (or locally) based on security needs, as recognized in the art.

Re claim 7, it has been discussed above that samples are received and stored for providing security/authentication. It would have been obvious to one of ordinary skill in the art that such samples would be received by an authorized sample receiver in order to ensure security and reliability.

Re claims 8 and 36, as Baumann teaches voice recognition, the use of a sensor is an obvious expedient to complete the process, well known in the art.

Re claim 9, though silent to verifying characteristics, the Examiner notes that such characteristics are well known and conventional with auditory emissions/voice and would have been obvious to consider as part of authentication process, for accuracy.

Re claim 11, Black teaches the proffered sample is compared to a stored to verify the samples, as discussed above.

Re claim 12, it has been discussed above that a comparison is performed. The Examiner notes that it would have been obvious to one of ordinary skill in the art to use a microprocessor/controller/processor (interpreted as a local CPU) to electronically perform the comparison, in order to have an electronic (automated) means to quickly and reliably perform the comparison, as is conventional in the art.

Re claim 13, as the sample is stored, its interpreted as registered.

Re claim 14, Black teaches that a customer's account is linked to the biometric/signature data and can be used for payment and is linked to a credit or debit account (col 6, lines 46+ and abstract).

Re claim 15, the system of Black can be used by numerous individuals, who inherently have different information.

Re claim 19, though Black is silent to the sensor providing notification upon detection of a sample, the Examiner notes it is well within the skill in the art to provide such notification in order to inform the user that the sample is received/being processed, as a means to inform the user. As Black indicates when a sample has been authorized (transaction allowed), it would have

been obvious to indicate when a sample is read/detected as a means to guide the user through the transaction. Additionally, the Examiner notes that the mere authorization of a transaction can be broadly interpreted as providing notification upon detection of a sample because authorization cannot occur unless the sample was detected. Additionally, the Examiner notes that providing guidance to users involved in a transaction is an obvious expedient, well within the ordinary skill in the art.

Re claim 20, it has been discussed above that the device facilitates a financial transaction.

Re claims 21 and 33, though silent to secondary security procedures, the Examiner notes that such procedures (PIN, codes, passwords, etc) are all well known and conventional in the art for increased security. One would have been motivated to use such procedures for increased security. Additionally, the Examiner notes that the verification of the biometric samples of Black (signature, fingerprints, etc.), is also interpreted as a secondary security procedure.

Re claim 22, Black teaches proffering a sample scan to a scan sensor communicating with the system to initiate verification of a sample for facilitating authorization of a transaction (abstract, FIG. 1A, and as discussed above).

Black is silent to an auditory emissions/voice sample.

Baumann teaches an auditory emissions/voice sample, as discussed above.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Baumann, for system constraints, security, alternative biometrics, etc.

Re claim 23, the Examiner has interpreted the storing of the sample as it being registered with an authorized sample receiver.

Re claim 24, the Examiner notes that registering includes proffering the same (abstract, FIG. 5A, as discussed above).

Re claim 25, the limitations have been discussed above re claim 8.

Re claim 26, the Examiner notes that proffering includes initiating at least one of storing, comparing, and verifying the sample, as discussed above.

Re claim 27, the limitations have been discussed above re claim 6. The Examiner notes that a database is an obvious expedient, and that processing such information contained in at least the smartcard/reader/sensor/server/reader system is an obvious expedient to reliably authenticate a user during the attempted transaction.

Re claim 28, it has been discussed above that the proffered sample is compared with a stored sample.

Re claim 29, the Examiner notes that Black teaches (FIG. 4A) that a registration processor and print processor are used. As discussed above, it would have been obvious to one of ordinary skill in the art to use a local CPU in order to provide an electronic/automated/reliably means to accurately verify a sample, as is conventional in the art (see claim 12).

Re claim 30 the limitations have been discussed above re claim 9.

Re claim 32, though Black is silent to second proffered samples, the Examiner notes that it would have be obvious to one of ordinary skill in the art that the method/system of the present invention would apply to multiple users, and as such, would obvious include multiple proffered samples (first, second, third, etc., depending on the number of unique users).

Re claim 34, the limitations have been discussed above.

Re claim 35, Black teaches that the sample is detected at a sensor configured to communicate with the system via one of a smartcard/reader/network (FIG. 1A-1C).

Re claim 37, it has been discussed above that the sample is detected/stored/processed (abstract).

Re claim 38, the limitations have been discussed above re claim 3.

Re claim 39, Black teaches logging each sample by a transaction record (paragraph [0125]).

Re claim 42, the limitations have been discussed above re claim 11.

Re claim 40, the Examiner notes that it would have been obvious to one of ordinary skill in the art to log the samples at least temporarily, in order for them to be verified (stored in a buffer for example during comparison). Additionally, the examiner notes that storing/logging the samples associated with a transaction (more permanently then in a buffer) are well known and conventional in the art for recording keeping purposes (also see paragraph [0125] which teaches a transaction record).

Re claim 43, the limitations have been discussed above re claim 9.

Re claim 45, the Examiner notes that verifying the sample using information contained on one of a local database/remote database/third party controlled database would have been an obvious expedient in instances where the data is stored remote from the smartcard, as discussed above, for security concerns. A remote database provides a preferred means to organize data for efficient and easy storage and retrieval, and is conventional in the art.

Re claim 46, the limitations have been discussed above re claim 12.

4. Claims 15, 32, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baumann, as discussed above, in view of Martizen et al. (US 2002/0191816).

Re claims 15, 32, and 40 the teachings of Black/Baumann have been discussed above.

Black/Baumann is silent to different samples (of the same person) associated with a different one of personal information, credit card information, etc.

Martizen et al. teaches different biometric samples associated with different personal information (different fingers with different accounts) (FIG. 6A). The Examiner notes that the sample (as claimed) is interpreted as a biometric.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baumann with those of Martizen et al.

One would have been motivated to do this in order to permit multiple accounts to be accessed with personalized security.

Though Martizen et al. is drawn towards different fingerprints, the Examiner maintains that it is well known and conventional in the art that different biometrics can be used to control access (hand geometry, voice, fingerprints, retina scans, signatures, etc). Accordingly, the Examiner believes that Martizen can be relied upon for the teachings of different samples to control access, where the type of biometric sample chosen, would have been obvious to one of ordinary skill in the art, given that there are numerous recognized and interchangeable biometrics that are accepted to control access.

5. Claims 10, 31, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baumann, as discussed above, in view of (Sharma et al. (US 6,480,825).

Re claims 10, and 31, and 41, the teachings of Black have been discussed above.

Black/Baumann is silent to detecting false noise samples.

Sharma et al. teaches detecting false voice samples (recordings) (abstract).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baumann with those of Sharma et al.

One would have been motivated to do this to detect false (not live) voice samples.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baumann/Martizen et al., as discussed above, in view of Moebs et al. (US 2005/0065872).

Re claim 16, the teachings of Black/Baumann/Martizen et al. have been discussed above.

Martizen et al. teaches a biometric sample is associated with at least one of a first user account, wherein the first account comprises personal information, credit card information, etc. and the first account is different than the second account (different samples), but it silent to primary and secondary associating.

Moebs et al. teaches that a customer can avoid overdraft by preauthorized the institution to tie the customers checking account into the other accounts (paragraph [0017]). The Examiner notes that such protection is well known in the art, and is interpreted to include primary and secondary associating. It would be obvious for the accounts to have the information in order to keep track and identify them.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baumann/Martizen et al. with those of Moebs et al. for overdraft protection.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baumann, as discussed above, in view of Teicher et al. (US 6,257,486).

Re claim 17, the teachings of Black/Baumann have been discussed above.

Black/Baumann is silent to mutual authentication upon verification of the proffered sample.

The Examiner notes that mutual authentication is well known and conventional in the art, as a security measure.

It would have been obvious to one of ordinary skill in the art to authenticate upon verification of a sample, as a means to ensure security. Specifically, Teicher et al. teaches mutual authentication being completed between a reader and a card for security (col 7, lines 35+).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baumann with those of Teicher et al.

One would have been motivated to do this in order to employ well-known security measures.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baumann, as discussed above, in view of Goodman (US 2002/0043566).

Re claim 18, the teachings of Black/Baumann have been discussed above.

Black is silent to deactivation of the smartcard when the sample is rejected.

Goodman teaches deactivation of a card if a predetermined amount of failed PIN attempts are detected (paragraph [0029]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baumann with those of Goodman et al.

One would have been motivated to do this in order to increase system security. For example, if a person attempting to illegally use the smartcard was unable to correctly sign (match the stored sample), disabling the smartcard would provide security for the rightful owner, while still permitting them to make a mistake themselves without their device being disabled.

9. Claims 21 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baumann, as discussed above, in view of Jensen et al. (US 2005/0165684).

The teachings of Black/Baumann have been discussed above.

Black/Baumann is silent to secondary security procedure.

Jensen et al. teaches such limitations (paragraph [0081]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baumann with those of Jensen et al.

One would have been motivated to do this for security.

Additional Remarks

10. The Examiner notes that there are numerous art recognized biometric means of identification (hand geometry, signature, fingerprint, retinal scan, voice print, DNA, etc.). The Examiner believes it is obvious to one of ordinary skill in the art that the teachings of above cited biometric security references in reference to different types of biometrics could be applied to the specific biometric of hand geometry, as means to provide biometric security for users. The fact that a reference may disclose a particular type of biometric being used does not preclude such teachings as being non-obvious when used with a different type of biometric, as interpreted by the Examiner. Biometrics represents unique features to identify a user. The replacement of one

type with another is an obvious expedient, within the ordinary skill in the art. Accordingly, the replacement of one known sample type with another obviates the user of technology/components, designed to detect and process such samples. The verification of body heat/blood flow, for example is well known in the art for fingerprint analysis and hand geometry.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see attached PTO-892), noting the prior art to (US 2006/0173291) which appears very similar to the current claims, and does not appear to be assigned to American Express.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

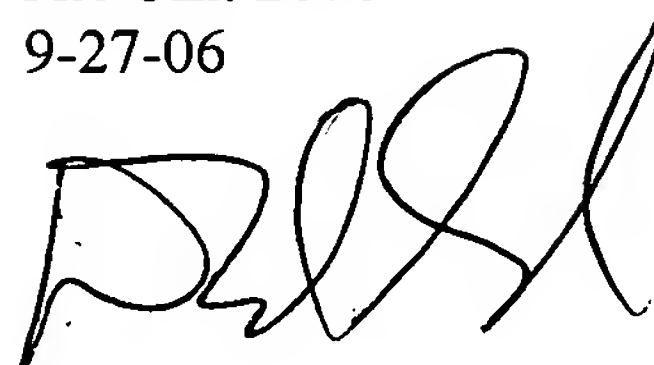
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 2876

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D. Walsh

Daniel I Walsh
Examiner
Art Unit 2876
9-27-06

A handwritten signature in black ink, appearing to read 'DW', with a large, stylized flourish extending from the end.

DANIEL WALSH
PRIMARY EXAMINER